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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN MARZOLIN
and DAVID QUERE

Appeal 2009-003530
Application 09/926,367
Technology Center 1700

Decided: August 14, 2009

Before BRADLEY R. GARRIS, BEVERLY A. FRANKLIN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of our Decision, dated June 17, 2009, wherein we affirmed the Examiner's rejections of the appealed claims including the § 102 rejection of claims 1 and 2 as being anticipated by Huang.

In their Appeal Brief, Appellants had argued that claim 1 distinguishes from the alternating hydrophobic and hydrophilic surface

regions of Huang's substrate. According to Appellants, this is because "[t]he claimed textured substrate is characterized by the formation and growth of water drops on the whole of its surface and by an improved flow of the drops, due to the hydrophobic/oleophobic properties of the substrate and to the particular relief present on the whole of its surface" (App. Br. 5; emphasis added). In our Decision, we explained that this argument was unpersuasive for the following reasons:

We do not agree with Appellants that claim 1 is limited to a substrate which "is characterized by the formation and growth of water drops on the whole of its surface" (*id.*; emphasis added). As previously indicated, the last paragraph on page 9 of Appellants' Specification describes an embodiment which comprises alternating hydrophobic and hydrophilic surface regions and which therefore corresponds in structure and function to the substrate shown in Figures 1-3 of Huang. Appellants point to nothing in claim 1 which excludes their embodiment described on Specification page 9 or the corresponding embodiment shown in Figure 1 of Huang. Therefore, when claim 1 is given its broadest reasonable interpretation consistent with the Specification, the claim 1 substrate is structurally indistinguishable from Huang's substrate shown in Figures 1-3 as correctly found by the Examiner.

(Decision 7).

In their Request for Rehearing, Appellants argue that appealed claim 1 excludes their embodiment described on Specification page 9 and correspondingly the embodiment shown in Figure 1 of Huang. Appellants express their argument as follows:

The limitation that the substrate be hydrophobic/oleophobic was added to Claim 1 by amendment filed December 1, 2005 to the body of the claim, and, in an effort to stress the importance of this limitation, was also added

to the preamble for purposes of emphasis by the amendment filed June 5, 2006. By such amendment, the embodiment described in the specification at page 9, last paragraph was necessarily excluded from the scope of the claims. Indeed, a hydrophobic/oleophobic substrate cannot comprise a hydrophobic relief surface and a hydrophilic lower surface, as described in the specification at page 9, last paragraph. Thus, it is clear error for the Board to find that giving Claim 1 its broadest reasonable interpretation consistent with the specification, the Claim 1 substrate is structurally indistinguishable from Huang's substrate. Clearly, contrary to the findings by both the Examiner and the Board, the structure of Huang's article is different from, and not suggestive of, the presently-claimed substrate. Indeed, Appellants reiterate that Huang's concept is the opposite of that of the presently-claimed invention, as argued in the Appeal Brief, and as the Board has found was incorrect (Decision at 7).

(Request, ¶¶ bridging 2-3).

This argument now presented by Appellants in their Request for Rehearing is unsuccessful for two reasons.

First, the argument appears to be untimely. As we expressly observed in our Decision, Appellants in their Appeal and Reply Briefs had pointed "to nothing in claim 1 which excludes their embodiment described on Specification page 9 or the corresponding embodiment shown in Figure 1 of Huang" (Decision 7). It appears that Appellants are now arguing for the first time before the Board that the "hydrophobic/oleophobic" recitation of claim 1 excludes their embodiment described on Specification page 9 and the corresponding embodiment shown in Figure 1 of Huang. Except under circumstances not relevant here, arguments not raised in the Briefs before the Board and evidence not previously relied upon in the Brief and any

Reply Briefs are not permitted in a Request for Rehearing. 37 C.F.R. § 41.52(a)(1)(2008).

Second, Appellants have not explained why the "hydrophobic/oleophobic" recitation of claim 1 is thought to exclude a substrate which contains both hydrophobic and hydrophilic regions as in Appellants' Specification page 9 embodiment and Huang's Figure 1 embodiment. In each of these embodiments, it is seemingly accurate to characterize the substrate as being hydrophobic since the substrate contains a hydrophobic region. We emphasize that Appellants do not identify any recitation in claim 1 which requires the substrate to consist solely of hydrophobic regions only.

For the above stated reasons, we maintain our determination that Appellants have failed to show in the record of this appeal error in the Examiner's finding that the substrate of claim 1, including the functional limitation recited in the last clause of claim 1, is disclosed either explicitly or inherently by Huang.

Appellants also argue that we erred in affirming the Examiner's § 102 rejection of claim 2. The circumstances regarding this claim rejection are as follows.

In the Answer, the Examiner found that the organosiloxane coupling agents disclosed in column 7 of Huang constitute silicones and therefore satisfy the silicone requirement of claim 2 (Ans. 4). Appellants responded to this finding by arguing:

"In reply, a siloxane, unless in polymeric form, i.e., a polysiloxane, cannot be a silicone. The siloxanes listed in Huang et al are examples of coupling agents, of which the

Board can take judicial notice are generally low molecular weight compounds."

(Reply Br. 3).

In our Decision, we regarded this argument as unpersuasive because "Appellants have provided the record before us with no basis whatsoever for the proposition that Huang's teaching of siloxanes as coupling agents fails to satisfy the silicone requirement of claim 2" (Decision 8).

In their Request, Appellants argue that our Decision regarding claim 2 was erroneous for the following reasons:

It was not until the Examiner's Answer that the Examiner changed her finding from silica being a silicone to a siloxane being a silicone. At that state of the prosecution, Board rules do not permit submission of evidence not already of record in the application. Since Appellants' argument was based on a notoriously well-known fact of silicon chemistry, and Appellants asked the Board to take judicial notice of this basic fact, how can the Board find that Appellants have provided the record with no basis for finding siloxanes as coupling agents are not silicones?

(Request 3).

As a matter of clarification, Appellants in their Reply Brief did not ask the Board to take judicial notice of a notoriously well-known fact of silicone chemistry, as asserted in the Request for Rehearing. Instead, Appellants in their Reply Brief stated that "[T]he Board can take judicial notice [that Huang's siloxane coupling agents] are generally low molecular weight compounds" (Reply Br. 3). However, this statement begs the question of whether the organosiloxanes of Huang have a molecular weight so low as to exclude them from the broad definition of siloxane polymers or silicones. In the appeal record on which our decision is based, Appellants

provided no evidence concerning this question and therefore failed to show error in the Examiner's rejection of claim 2.

We acknowledge Appellants' statements "[i]t was not until the Examiner's Answer that the Examiner changed her finding from silica being a silicone to a siloxane being a silicone" and, "[a]t that stage of the prosecution, Board rules do not permit submission of evidence not already of record in the application" (Request 3). These statements relate to considerations regarding whether the Examiner's rejection of claim 2 as presented in the Answer constitutes a new ground of rejection. *See* the Manual of Patent Examining Procedure (MPEP) § 1207.03 (Rev. 3, Aug. 2005). The Board is not an appropriate forum by which to raise and resolve such considerations. These considerations must be raised and resolved by petition not appeal. *See* MPEP § 1002.02(c)(Rev. 2, May 2004) and § 1201 (Rev. 3, Aug. 2005).

For these reasons, Appellants' above-quoted statements are not relevant to whether the appeal record presented to us adequately supports our decision to affirm the Examiner's rejection of claim 2.

Appellants' Request for Rehearing is denied.

DENIED

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Application 09/926,367

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